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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/048,838 03/27/98 JOHNSON

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EXAMINER

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ELDRIDGE, J

ART UNIT

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UNITED STATES DEPARTMENT OF COMMERCE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20

Application Number: 09/048,838

Filing Date: 03/27/98

Appellant(s): Johnson

MAILED

AUG 15 2001

Stanley C. Spooner
For Appellant

GROUP 3600

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 6-4-01.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

Art Unit: 3644

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Art Unit: 3644

5,071,092

Williams et al

12-1991

5,156,360

Shine

10-1992

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-10 and 13-17 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office action, Paper No. 17.

(11) *Response to Argument*

Applicant first attempts to argue that “rubber or rubber-like material” is not indefinite under 35 USC 112 because the terms appear in the dictionary. The definition cited merely makes the case for indefiniteness in the context of a patent claim. The quoted definition shows that there are alternative properties which can be considered “rubber-like”, ie. “esp. In physical properties (as elasticity and toughness)”. It is totally unclear as to which of the many properties of rubber are being claimed as limitations in the phrase “rubber-like”. Is it flexibility, non-conductivity, resin composition, elasticity, or density? There is no way to tell from the claim language or even the specification. Many words, such as “rubber-like”, have a definition as far as the English language is concerned, but they still fail to meet the requirements of being definite in the context of claim language and 35 USC 112. The phrase used is also indefinite since it is alternative. The example given by Applicant from the MPEP to describe situations where expressions using “or” is acceptable is not applicable to this situation. That example discloses an list of materials in which the limitation being claimed is

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clear, ie. they all are magnetic materials. In the present case we don't know what limitations are in common with the listed elements and there is definite ambiguity as to what the second element would be.

Applicant also argues that there is no disclosure of the claimed "composite sheet element" in the prior art and that the prior art does not show the sheet element as being a "rubber or rubber-like material." To begin with, the term "composite sheet element" is a broad term which is met by the cited prior art. The Examiner believes that the flexible seal of Williams et al that comprises a plurality of slidable overlapping layers of nylon or spring steel reads over the broad claim language since it forms an uninterrupted surface or sheet of flexible material having a plurality of plies which forms the required seal. It can be considered a "composite" either by virtue of its being formed from a plurality of elastic elements or because the flexible elements are formed with a separate, low friction, coating. In any case, a flexible and continuous seal is formed. Shine is introduced because the seal of Williams et al does fail to be comprised of fabric. Shine clearly teaches that it is known to use "rubber or rubber-like" composite sheet elements comprising fabric with reinforcing plies as seals on aircraft cowling structures. Applicant argues that there is no motivation to combine, but it is well established patent practice to allow the substitution of elements as being obvious replacements when the elements are performing the same function in substantially the same way. This is because one might be less expensive, better meet the particular parameters required by a particular situation, or merely be more easily available. In this case, the elements are clearly disclosed

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as being aircraft seals and it is clearly established that they both perform the sealing in the same manner and even have roughly the same structure (flexible plies forming a continuous surface), although made from different materials. Applicant also makes some argument about the structure using the seal in Shine, but this is a moot point because the entire structure is disclosed in Williams et al and Shine is merely being relied upon for the seal material.

Finally, Applicant argues that the Examiner “fails to rebut appellant’s evidence of unexpected result in the claimed invention.” Applicant also states that the Examiner has never “disputed or otherwise cast doubt upon the evidence of this unexpected result.” In the first place, Applicant has failed to provide any “evidence of unexpected results.” Applicant merely recites some prior art and gives his opinion of the various merits of that art. Applicant then states that “Somewhat surprisingly, we have found that it is possible to make a composite rubber or rubber-like seal arrangement incorporating fabric reinforcement which is capable of meeting many if not all of the above demands.” There is no evidence of how a person of ordinary skill in the art would expect such a seal to perform, merely his statement that he was “somewhat” surprised. Applicant also failed to bring this argument forward during prosecution and is relying on an unsupported statement in the disclosure. The Examiner did state in the last Office Action that it is well known in the art to use such seals and to have fabric in the plies to “prolong the life of the flexible seal arrangement” and to have the “inherent increased strength by including fabric within the seal.” Clearly the disclosed prior art and the Examiner expected acceptable performance from such a seal structure.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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JWE
August 11, 2001

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